



Docket No.: 1185.1018

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of:

Kayoko MASAKI et al.

Serial No. 08/772,259

Group Art Unit: 2872

Confirmation No. 5740

Filed: December 23, 1996

Examiner: T. Nguyen

For: SURFACE LIGHT SOURCE DEVICE OF SIDE LIGHT TYPE (As Amended)

REPLY BRIEF UNDER 37 C.F.R. §§ 1.193

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Pursuant to the Appeal Brief, filed July 24, 2003, and the Examiner's Answer, mailed October 21, 2003 (paper no. 43), Applicants hereby submit this Reply Brief to the Board of Patent Appeals and Interferences.

I. INTRODUCTION

The Examiner's Answer restates the outstanding rejection of the claims on pages 3-5, and thereafter provides the Examiner's comments regarding Applicants' Appeal Brief. The Examiner's has essentially copied and pasted the Examiner's previous remarks presented in the Office Action dated August 1, 2002, although portions of the first full paragraph, on page 6 of the Reply Brief, have slightly different wording, though essentially the same meaning.

Thus, it would appear that the Examiner has not addressed the particular comments presented in the Appeal Brief, but repeated previous arguments. In particular, the Examiner has failed to address the particular legal requirements, as well as those particular legal issues presented in the Appeal Brief, e.g., the fact that the Examiner is essentially basing the obviousness rationale on "the knowledge generally available to one of ordinary skill in the art," which is clearly improper, in this situation, as supported by In re Lee, 61 USPQ2d 1430 (CA FC 2002).

II. EXAMINER'S COMMENTS

As the Examiner's comments proceed through a numbered analysis, the following comments will similarly address each comment in turn.

In the Examiner's first point, the Examiner makes the argument that the cited references cannot be argued individually, but must be considered as a whole with the proffered combination, i.e., the modification of the prior art (Prior Art) disclosed in the background of the present application.

However, regardless of the combination proffered by the Examiner, each reference can and should be discussed to determine the appropriateness of the combination. For example, as previously pointed out, Ishikawa et al., U.S. Patent No. 5,600,455, is related to a solution of a particular problem in the arrangement disclosed in Ishikawa et al. If the rationale behind the modification in Ishikawa et al. is unrelated to Prior Art, then that knowledge is important and relevant to support a conclusion that the underlying rationale in Ishikawa et al. would not provide proper motivation or suggestion for making the same modification in Prior Art.

Thus, it is important to understand what Ishikawa et al. and Prior Art are each disclosing to discern whether the outstanding rejection is rational. Therefore, the addressing of Ishikawa et al. and Prior Art individually, as well as the addressing of the combination as a whole, are appropriate.

In the Examiner's second numbered argument, the Examiner sets forth the advantages of Ishikawa et al. In particular, the Examiner points out that Ishikawa et al. is directed toward a surface light source device, with a light control member with a prismatic configuration formed on one surface of each prism. The Examiner sets forth: "[Ishikawa et al. discloses] the reduction of the stripe pattern, of use of a light control member in a liquid crystal display to the use of a light control member without the prism configuration as those disclosed in the prior art. While applicant made numerous arguments/viewpoints about the light control member provided by Ishikawa et al., applicant has refused/neglected to recognize the important feature disclosed by Ishikawa et al. In particular, the important thing disclosed/suggested to one of skilled in the art made by Ishikawa et al. is that they teach that one of the two slopes constituting each of the prism/projection is roughed/roughed for the purpose of providing a more uniform in light distribution after light passing such a prism."

This argument is essentially the same as presented in the previous Office Action, i.e., since Ishikawa et al. has roughened prism surfaces "for a more uniform in light distribution" it would have been obvious to modify Prior Art to include the same. The Examiner makes the point that the Applicants have failed to recognize this feature. Rather, it has been repeatedly pointed out that, for arguments sake, although this may be a feature of Ishikawa et al., there is no support in the record inferring that the same feature should be imported into Prior Art.

For example, the Examiner has provided no support for the conclusion that Prior Art would suffer from the same problems as Ishikawa et al. and accordingly need the features of Ishikawa et al. In addition, it has repeatedly been pointed out that the prism systems in Ishikawa et al. and Prior Art are in completely different configurations and for completely different types of surface light source devices.

Essentially, the Examiner is interpreting the solution in Ishikawa et al., in the vaguest sense, as providing for uniform light distribution, and inferring that it would have obviously been advantageous for Prior Art to have a uniform light distribution, and therefore obvious to modify Prior Art to have the roughened surfaces disclosed in Ishikawa et al.

However, it is more proper to understand why Ishikawa et al. actually implemented the roughened prism surfaces, and what problems were being solved by those implementations. If the same problems are not present in Prior Art then Prior Art would not need those implementations, i.e., it would not have been obvious to make the proffered combination.

Thus, regardless of the important features disclosed in Ishikawa et al., of most primary importance is whether it would have been obvious to implement the same features in Prior Art. Based on all the previous remarks, it is respectfully submitted that the Examiner has failed to provide any support in the record as to why one skilled in the art would incorporate the roughened prism surfaces of Ishikawa et al. into Prior Art. Rather, as noted below, the outstanding rejection would more likely be based primarily on what the Examiner believes to be obvious.

Of brief interest here is that the outstanding issues still appear to stem from the Examiner's initial rejections and discussions with the Examiner, where the Examiner believed that if one skilled in the art were to look at Prior Art and Ishikawa et al. one skilled in the art would have tried the solution in Ishikawa et al. in Prior Art to solve some problem, even if that problem was unknown. The inadequacy of this rationale was previously pointed out, though the same would appear to still be resistent within the outstanding rejection.

In the Examiner's third point, the Examiner points out that if the roughened surfaces disclosed in Ishikawa et al. were incorporated into Prior Art the result would be to reduce the effect of the reflector in Prior Art.

Similar to above, this approach would appear to be more of a hindsight approach, where the Examiner makes the proffered combination and then supports the same based on the solution of the problem disclosed in the present application.

The Appeal Brief discussed in depth the systems of Ishikawa et al. and Prior Art, and particularly pointed out the inadequacies of this rationale.

Lastly, in the Examiner's fourth point, the Examiner more distinctly points out the source of the purported motivation for incorporating the roughened prism surfaces of Ishikawa et al. into Prior Art. The Examiner states that "[i]n this case, the obviousness is established by the knowledge generally available to one of ordinary skill in the art."

The Examiner thereafter points out the differences between Prior Art and the claimed invention, that Ishikawa et al. discloses the use of roughened prism surfaces to improve uniform manner of light distribution, and that Prior Art and Ishikawa et al. are in the same field.

Thus, somehow, one skilled in the art would have understood the obviousness of modifying Prior Art, in view of Ishikawa et al., to be particularly modified as claimed.

As noted above, this rationale is particularly contrary to current Federal Circuit case law, and in particular In re Lee 61 USPQ2d 1430 (CA FC 2002). The Federal Circuit particularly pointed out that the conclusion of obviousness cannot be made from "common knowledge and common sense" of ordinary skill in the art without any specific hint or suggestion in the particular reference.

Here, again, the Examiner would appear to be rehashing the previous argument that one skilled in the art would have tried to modify Prior Art to have roughened prism surfaces, as illustrated in Ishikawa et al., regardless of the underlying reason, though the Examiner here would appear to be relying on the advantage of generating "a uniform in light distribution," which would not appear to be relevant to Prior Art.

III. CONCLUSION

In view of the law and the facts stated herein, the Appellants respectfully submit that the Examiner has failed to cite references or motivation supporting the outstanding obviousness type rejections.

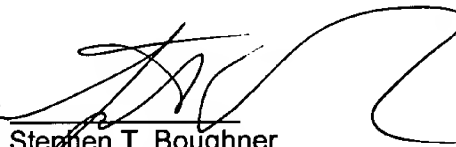
For all the foregoing reasons, the Appellants respectfully submit that the cited prior art does not teach or suggest the presently claimed invention. The claims are patentable over the prior art of record and the Examiner's findings of unpatentability regarding claims 4-7 and 9-11 should be reversed.

The Commissioner is hereby authorized to charge any additional fees required in connection with the filing of the Reply Brief to Deposit Account No. 19-3935.

Respectfully submitted,

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Date: 12/12/03

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